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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998				
EXAMINER MEINECKE DIAZ, SUSANNA M				
ART UNIT		PAPER NUMBER		
3623				

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/782,977

Applicant(s)

MILLER, DAVID S.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-68 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 21-68 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/30/6/2/2/23.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 21-68 are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 21-28 and 45-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 21-28 and 45-52 do not expressly recite that the computer program is executable; therefore, claims 21-28 and 45-52 are interpreted as software *per se*, which is non-statutory.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 21-68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Independent claims 21, 29, 37, 45, 53, and 61 recite the step of electronically collecting tax data from a tax data provider. It is not clear how this electronic collection of data is performed. Claims 24-26, 32-34, 40-42, 48-50, 56-58, and 64-66 limit the recited tax data to "tax data correspond[ing] to at least one item of tax liability reported on at least one of Internal Revenue Service ('IRS') form, a state form, a local form, and a foreign tax form," "wherein said IRS form comprises one of an IRS Form 1040, an IRS Form 1040EZ, an IRS Form W-2, an IRS Form 1098, and an IRS Form 1099." It is not clear whether this limitation is meant to be a positive recitation of actively reporting data on an Internal Revenue Service ("IRS"), state, local, or foreign tax form or whether the limitation provides a mere clarification of the tax data as being the type of data that one would typically find reported on an Internal Revenue Service ("IRS"), state, local, or foreign tax form. In other words, do the claims require that the tax data expressly be reported and, if so, to whom? If Applicant submits that the intended scope of these claims necessitates an active reporting of the tax data on one of the recited forms, what is the extent of the data reported? In other words, does Applicant's invention report the actual image data or an OCR version of the contents of an entire W-2, 1098, or 1099 form or merely any data that would typically be found on each of the respective forms and used for tax reporting purposes? Once the tax data is received electronically from a tax data provider, how does the means for preparing electronically an electronic return know how to manipulate such data to perform the proper calculations necessary to complete the electronic tax return? The specification provides limited explanation beyond the fact that W-2, 1098, and 1099-related data may be downloaded to

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automatically prepare an electronic tax return. Based on the disclosure in the specification, the Examiner interprets the claim scope as embodying any means/method for transferring data typically gleaned from a W-2, 1099, and 1098 form, in any format (and not necessarily inclusive of all of the data printed on the standard IRS version of each respective form), to prepare a tax return. If Applicant asserts a different interpretation, then proper support from the specification should be provided.

Also ambiguous is the intended scope of the phrase "tax data correspond[ing] to..." recited in claims 24, 32, 40, 48, 56, and 64. Does the word "corresponding" imply that the tax data is expressly limited to data values printed directly on one of the various recited tax forms or merely that the tax data is somehow related to other information that is printed on one of the various recited tax forms? This is especially confusing because the specification never mentions these particular types of forms or even that data reported on IRS, state, local, and foreign tax forms *per se* is expressly used as part of the intended invention. Pages 9-10 and 13 of the specification provide various examples of tax data providers (including employers, banks, mortgage institutions, and federal, state, local, and foreign taxing authorities) and various examples of tax data (including a payroll statement, bank statement, mortgage statement, and charity statement); however, neither excerpt addresses the details of specific tax forms from which tax data is directly garnered.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 21-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 21, 29, 37, 45, 53, and 61 recite the step of electronically collecting tax data from a tax data provider. It is not clear how this electronic collection of data is performed. Claims 24-26, 32-34, 40-42, 48-50, 56-58, and 64-66 limit the recited tax data to "tax data correspond[ing] to at least one item of tax liability reported on at least one of Internal Revenue Service ('IRS') form, a state form, a local form, and a foreign tax form," "wherein said IRS form comprises one of an IRS Form 1040, an IRS Form 1040EZ, an IRS Form W-2, an IRS Form 1098, and an IRS Form 1099." It is not clear whether this limitation is meant to be a positive recitation of actively reporting data on an Internal Revenue Service ("IRS"), state, local, or foreign tax form or whether the limitation provides a mere clarification of the tax data as being the type of data that one would typically find reported on an Internal Revenue Service ("IRS"), state, local, or foreign tax form. In other words, do the claims require that the tax data expressly be reported and, if so, to whom? If Applicant submits that the intended scope of these claims necessitates an active reporting of the tax data on one of the recited forms, what is the extent of the data reported? In other words, does Applicant's invention report the actual image data or an OCR version of the contents of an entire W-2, 1098, or 1099 form or merely any data that would typically be found on each of the respective forms and used for tax reporting purposes? Once the tax data is received electronically from a tax data provider, how does the means for preparing electronically an electronic return

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know how to manipulate such data to perform the proper calculations necessary to complete the electronic tax return? The specification provides limited explanation beyond the fact that W-2, 1098, and 1099-related data may be downloaded to automatically prepare an electronic tax return. Based on the disclosure in the specification, the Examiner interprets the claim scope as embodying any means/method for transferring data typically gleaned from a W-2, 1099, and 1098 form, in any format (and not necessarily inclusive of all of the data printed on the standard IRS version of each respective form), to prepare a tax return. If Applicant asserts a different interpretation, then proper support from the specification should be provided.

Also ambiguous is the intended scope of the phrase "tax data correspond[ing] to..." recited in claims 24, 32, 40, 48, 56, and 64. Does the word "corresponding" imply that the tax data is expressly limited to data values printed directly on one of the various recited tax forms or merely that the tax data is somehow related to other information that is printed on one of the various recited tax forms? This is especially confusing because the specification never mentions these particular types of forms or even that data reported on IRS, state, local, and foreign tax forms *per se* is expressly used as part of the intended invention. Pages 9-10 and 13 of the specification provide various examples of tax data providers (including employers, banks, mortgage institutions, and federal, state, local, and foreign taxing authorities) and various examples of tax data (including a payroll statement, bank statement, mortgage statement, and charity statement); however, neither excerpt addresses the details of specific tax forms from which tax data is directly garnered.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 21, 22, 24, 29, 30, 32, 37, 38, 40, 45, 46, 48, 53, 54, 56, 61, 62, and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by the integration of MacInTax with Dollars & Sense, as disclosed in Beamer ("A Marriage of Convenience") and further supported by the disclosure of the article, "It's W-2 Time." In accordance with MPEP § 2131.01, "It's W-2 Time" is cited as part of the rejection under § 102 to show various characteristics of MacInTax that are deemed to be inherent to the version of MacInTax described in Beamer. Beamer was published in March 1987 while "It's W-2 Time" was published on February 9, 1987 (within one month of each other and, incidentally, during the traditional tax season in the United States), thereby further supporting the Examiner's assertion that Beamer and "It's W-2 Time" describe features of the same version of MacInTax.

The integration of MacInTax with Dollars & Sense discloses a computer-readable medium embodying a computer program for tax data collection by an electronic intermediary, said computer program comprising code segments for:

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[Claim 21] connecting electronically said electronic intermediary to a tax data provider (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense);

collecting electronically tax data from said tax data provider, wherein said tax data is taxpayer specific tax data (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return);

processing electronically said tax data collected electronically from said tax data provider to obtain processed tax data (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return. Use of software executed by a computer to perform tax computations for preparing a tax return is indicative of electronic and automatic performance of these computations. In other words, the computer is an electronic device that automates such computations as opposed to performing the calculations completely manually by a human; "It's W-2 Time" expressly states that MacInTax performs all tax calculations on the computer (¶¶ 3, 11)); and

preparing electronically an electronic tax return using said processed tax data (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can

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electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return. Use of software executed by a computer to perform tax computations for preparing a tax return is indicative of electronic and automatic performance of these computations. In other words, the computer is an electronic device that automates such computations as opposed to performing the calculations completely manually by a human; "It's W-2 Time" expressly states that MacInTax performs all tax calculations on the computer (§§ 3, 11));

[Claim 22] wherein said taxpayer specific tax data comprises taxpayer specific data related to tax liability (Beamer: §§ 3, 4, 6, 15, 16, 23, 26);

[Claim 24] wherein said taxpayer specific tax data corresponds to at least one item of tax liability reported on at least one of an Internal Revenue Service ("IRS") form, a state form, a local form, and a foreign tax form (Beamer: §§ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return. Completion of an IRS tax form is expressly disclosed by Beamer; therefore, by using data downloaded from a bank to complete the IRS tax form, said data qualifies as at the very least "tax data corresponding to data reported on an Internal Revenue Service ("IRS") tax form").

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[Claims 29, 30, 32] Claims 29, 30, and 32 recite limitations already addressed by the rejection of claims 21, 22, and 24 above; therefore, the same rejection applies.

[Claims 37, 38, 40] Claims 37, 38, and 40 recite limitations already addressed by the rejection of claims 21, 22, and 24 above; therefore, the same rejection applies.

The integration of MacInTax with Dollars & Sense discloses a computer-readable medium embodying a computer program for tax data collection by an electronic intermediary, said computer program comprising code segments for:

[Claim 45] connecting electronically a tax data provider to said electronic intermediary (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense); and

providing electronically tax data from said tax data provider to said electronic intermediary, wherein said tax data is taxpayer specific tax data (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return);

wherein said electronic intermediary processes electronically said tax data collected electronically from said tax data provider to obtain processed tax data (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a

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home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return. Use of software executed by a computer to perform tax computations for preparing a tax return is indicative of electronic and automatic performance of these computations. In other words, the computer is an electronic device that automates such computations as opposed to performing the calculations completely manually by a human; "It's W-2 Time" expressly states that MacInTax performs all tax calculations on the computer (§§ 3, 11)); and

wherein said electronic intermediary prepares electronically an electronic tax return using said processed tax data (Beamer: §§ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return. Use of software executed by a computer to perform tax computations for preparing a tax return is indicative of electronic and automatic performance of these computations. In other words, the computer is an electronic device that automates such computations as opposed to performing the calculations completely manually by a human; "It's W-2 Time" expressly states that MacInTax performs all tax calculations on the computer (§§ 3, 11));

[Claim 46] wherein said taxpayer specific tax data comprises taxpayer specific data related to tax liability (Beamer: §§ 3, 4, 6, 15, 16, 23, 26);

[Claim 48] wherein said taxpayer specific tax data corresponds to at least one item of tax liability reported on at least one of an Internal Revenue Service ("IRS") form, a state

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form, a local form, and a foreign tax form (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense. This downloaded information is used to assist in completing one's tax return. Completion of an IRS tax form is expressly disclosed by Beamer; therefore, by using data downloaded from a bank to complete the IRS tax form, said data qualifies as at the very least "tax data corresponding to data reported on an Internal Revenue Service ("IRS") tax form").

[Claims 53, 54, 56] Claims 53, 54, and 56 recite limitations already addressed by the rejection of claims 45, 46, and 48 above; therefore, the same rejection applies.

[Claims 61, 62, 64] Claims 61, 62, and 64 recite limitations already addressed by the rejection of claims 45, 46, and 48 above; therefore, the same rejection applies.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 23, 25-28, 31, 33-36, 39, 41-44, 47, 49-52, 55, 57-60, 63, and 65-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over the integration of MacInTax with Dollars & Sense, as disclosed in Beamer ("A Marriage of Convenience") and further

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supported by the disclosure of the article, "It's W-2 Time", as applied to claims 21, 24, 29, 32, 37, 40, 45, 48, 53, 56, 61, and 64 above.

[Claims 23, 25, 26] Beamer teaches the download of bank account-related tax data from a bank for use in electronically preparing and filing a tax return (Beamer: ¶¶ 3, 4, 6, 15, 16, 23, 26). Beamer does not expressly teach that the bank account-related tax data is downloaded as data corresponding to an IRS Form 1099 *per se*; however, Official Notice is taken that it is old and well-known in the art of United States tax returns that the IRS Form 1099 summarizes information from a bank that a taxpayer needs to complete his/her tax return(s). For example, one version of the IRS Form 1099 includes data such as taxable interest earned on a bank account, i.e., information typically found on a bank statement. Beamer does not expressly teach that the downloaded tax data is expressly printed on an IRS Form 1040, 1040EZ, W-2, 1098, or 1099; however, Beamer clearly lays the groundwork for electronically downloading tax-related data, such as bank statement data (i.e., data that is typically listed on an IRS Form 1099), and then using this data for automatically and electronically performing the calculations necessary to file an electronic tax return. The Examiner asserts that it is extremely old and well-known in the art of tax filing that, similar to the IRS Form 1099, the IRS Forms 1040, 1040EZ, W-2, and 1098 also contain information that is necessary for many taxpayers in the United States to completely fill out their tax returns. Since Beamer's disclosure describes software that aims to automate much of the tax data collection and tax return preparation and filing process, the Examiner asserts that one of ordinary skill in the art at the time of Applicant's invention would have found it obvious and been

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motivated to modify the software disclosed by Beamer to download data gleaned directly from a taxpayer's IRS Forms 1040, 1040EZ, W-2 (which includes income and wages data), 1098, and/or 1099 (which includes interest data) in order to more quickly and efficiently enable a taxpayer to automate the entire tax data collection and tax return preparation and filing process, especially since the taxpayer may already do so with bank statements, thereby reaping the benefits disclosed in Beamer.

[Claims 27, 28] As per claims 27 and 28, Beamer teaches means for connecting electronically an electronic intermediary to a tax data provider using an electronic link and means for collecting electronically tax data from said tax data provider using an electronic link, wherein the electronic link is an electronic data network (¶¶ 3, 4, 6, 15, 16, 23, 26 -- The tax preparation software, e.g., MacInTax, can electronically connect to and download relevant financial information from a bank via a home accounting program, e.g., Dollars & Sense). Beamer does not expressly teach that this electronic data network is the Internet nor that tax data is collected via electronic mail; however, Official Notice is taken that it was old and well-known in the art of communications at the time of Applicant's invention to utilize the Internet and electronic mail for remote electronic data communications. The Internet and electronic mail both facilitate quick, efficient, and relatively inexpensive communications among remotely (even globally) located entities. Since Beamer's bank from which a taxpayer electronically downloads tax-related bank statement information is likely located remotely from the taxpayer, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Beamer to perform its downloads of bank

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statements via the Internet and/or electronic mail in order to facilitate quick, efficient, and relatively inexpensive communications among banks and taxpayers who are remotely (even globally) located.

[Claims 31, 33-36] Claims 31 and 33-36 recite limitations already addressed by the rejection of claims 23 and 25-28 above; therefore, the same rejection applies.

[Claims 39, 41-44] Claims 39 and 41-44 recite limitations already addressed by the rejection of claims 23 and 25-28 above; therefore, the same rejection applies.

[Claims 47, 49-52] Claims 47 and 49-52 recite limitations already addressed by the rejection of claims 23 and 25-28 above; therefore, the same rejection applies.

[Claims 55, 57-60] Claims 55 and 57-60 recite limitations already addressed by the rejection of claims 23 and 25-28 above; therefore, the same rejection applies.

[Claims 63, 65-68] Claims 63 and 65-68 recite limitations already addressed by the rejection of claims 23 and 25-28 above; therefore, the same rejection applies.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 21-68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No.

6,697,787. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 21-68 of the instant application recite limitations that are substantially similar to those recited in claims 1-18 of U.S. Patent No.

6,697,787. The main difference in the independent claims of each respective set of claims is that the claims in the instant application specify that the "tax data is taxpayer specific tax data." However, this limitation is deemed to be obvious since the end result is the preparation of an electronic tax return and it is old and well-known that preparation of a taxpayer's electronic tax return inherently requires input regarding taxpayer specific data.

14. Claims 21-68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No.

6,202,052. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 21-68 of the instant application recite limitations that are substantially similar to those recited in claims 1-20 of U.S. Patent No.

6,202,052. The main difference in the independent claims of each respective set of claims is that the claims in the instant application specify that the "tax data is taxpayer specific tax data." However, this limitation is deemed to be obvious since the end result

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is the preparation of an electronic tax return and it is old and well-known that preparation of a taxpayer's electronic tax return inherently requires input regarding taxpayer specific data. Also, independent claims 1, 15, and 19 of U.S. Patent No. 6,202,052 expressly recite that the electronic tax return is electronically filed with a taxing authority; however, such a limitation is deemed to be obvious since the Beamer reference (cited above) teaches that electronic filing of a tax return after preparation of the tax return is old and well-known and provides the benefit of speeding up the refund process (¶ 16).

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 22, 2005

Susanna Diaz
SUSANNA M. DIAZ
PRIMARY EXAMINER

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